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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,715	12/02/2004	Joe Howard	P15322-US1	9914
27045	7590	10/19/2005	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			LY, NGHI H	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/516,715	HOWARD, JOE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nghi H. Ly	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/02/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 12/02/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Reference AC under "OTHER PRIOR ART" PTO FORM 1449 will not be considered because applicant failed to submit legible copies.

### ***Specification***

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 11, 15, 16, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Reich et al (US 2002/0184256 A1).

Regarding claims 11, 18 and 20, Reich teaches a method of controlling a network entity of a mobile communication network and a mobile station (see Abstract and see fig.1, wireless connection between mobile station 12 and network), wherein the network entity and the mobile station are adapted to conduct a plurality of predetermined message exchange procedures in the course of which predetermined messages are exchanged between the network entity and the mobile station depending on the given procedure (see Abstract, [006], and [0065], see "message"), where the predetermined messages may be encrypted (see [003], see "encryption"), an encrypted message being any message of which at least a part is encrypted (see [0064], see "encrypt"), and where the network entity and the mobile station are adapted to conduct one or more encryption key generation procedures during which the network entity and the mobile station generate and store respective corresponding encryption keys in order to be able to encrypt and decrypt exchanged messages (see [0064], see "encrypt" and see Abstract, [006], and [0065], see "message"), the method comprises the steps of: if the network entity receives a message from the mobile station, determining whether the received message is encrypted (see [0064], see "encrypt" and see Abstract, [006], and [0065], see "message"),

if the received message is encrypted, determining whether a correct encryption key for decrypting the message is available to the network entity and, if no correct key

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is available, sending a predetermined triggering message to the mobile station (see [0064] and [0066]), and

upon receiving the predetermined triggering message, the mobile station interrupting the procedure in the course of which it sent the encrypted message for which the network entity did not have a correct key, and initiating an encryption key generation procedure (see [0064] and [0066]).

Regarding claim 15, Reich further teaches the one or more encryption key generation procedures comprise obtaining an encryption base value commonly available to the network entity and the mobile station at the time of conducting the encryption key generation procedure, and generating corresponding encryption keys in the network entity and the mobile station on the basis of the encryption base value (see [0059]).

Regarding claim 16, Reich further teaches the encryption base value is a regularly changed value that is broadcast by the network to listening mobile stations (see [0064] and [0066]).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reich et al (US 2002/0184256 A1) in view of Pang et al (US 6,931,543).

Regarding claim 12, Reich teaches claim 11. Reich does not specifically disclose the messages are arranged such that they have a first part and a second part, the first part being an unencrypted part that is not allowed to be encrypted, and the second part being encryptable.

Pang teaches the messages are arranged such that they have a first part and a second part, the first part being an unencrypted part that is not allowed to be encrypted, and the second part being encryptable (see column 4, lines 10-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Pang into the system of Reich in order to prevent data from being loss (see Pang, column 2, lines 33-34).

Regarding claim 13, Reich teaches claim 11. Reich does not specifically disclose the messages are arranged such that the first part contains an encryption indication of whether the second part is encrypted or not, and the determining of whether the second part of the received message is encrypted or not is achieved by analysing the encryption indication.

Pang teaches the messages are arranged such that the first part contains an encryption indication of whether the second part is encrypted or not, and the determining of whether the second part of the received message is encrypted or not is achieved by analysing the encryption indication (see column 4, lines 10-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Pang into the system of Reich in order to prevent data loss (see Pang, column 2, lines 33-34).

7. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reich et al (US 2002/0184256 A1) in view of D'Amico et al (US 5,077,790).

Regarding claim 17, Reich teaches claim 11. Reich does not specifically disclose the encryption conducted as a part of a registration procedure of the key generation procedure is mobile station with the network entity.

D'Amico teaches the encryption conducted as a part of a registration procedure of the key generation procedure is mobile station with the network entity (see column 1, lines 65 to column 2, line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of D'Amico into the system of Reich in order to a method for registration of a portable unit maybe utilized in a communication system the comprises a network controller (see D'Amico, column 1, lines 41-43).

Regarding claim 19, Reich teaches claim 18. Reich does not specifically disclose the controller is arranged to conduct the encryption key generation procedure as a part of a registration procedure of the mobile station with the mobile communication network.

D'Amico teaches the controller is arranged to conduct the encryption key generation procedure as a part of a registration procedure of the mobile station with the mobile communication network (see column 1, lines 65 to column 2, line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of D'Amico into the system of Reich in order to a method for registration of a portable unit maybe utilized in a communication system the comprises a network controller (see D'Amico, column 1, lines 41-43).

***Allowable Subject Matter***

8. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 14, the combination of Reich and Pang teaches the messages are arranged such that the first part contains a message type identifier identifying the type of the message (see Pang, column 4, lines 10-19). The combination of Reich and Pang fails to teach after having received a message from the mobile station, the network entity identifies the message type of the received message from the message type identifier and determines whether the identified message type belongs to a predetermined category, and sends the predetermined triggering message to the mobile station only if the message type of the received message falls into the predetermined category.



***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Law (US2005/0184145 A1) teaches secure wireless authorization system.
- b. Verbestel (US 2005/0198126 A1) teaches system and method of providing content in a multicast system.
- c. Anderson (US 2005/0182710 A1) teaches method of processing an electronic payment cheque.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

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*10/13/05*

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